

REMARKS

The Official Action of May 16, 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 1 has been amended, without narrowing the scope thereof, to make clear that the recitation in the last two (2) lines of the claim (reciting the amount of alkanediol and glycol ether in the ink composition) refers to the entire contents of alkanediol and glycol ether in the ink composition and not just to the at least one alkanediol and glycol ether recited in respective lines 3 and 4 of the claim. The specification as filed makes it clear that this was intended at, for example, page 8, lines 29-30 ("In the present invention, these substances may either be used alone or two or more of them can be used together.") taken in connection with the specification in the paragraph bridging pages 8 and 9, and at page 10, lines 13-15 ("When the total weight of the ink composition is set as a reference (100 wt%), the sum of the contents of alkanediol and glycol ether is 10 wt % or more but less than 20 wt%."). See, also, specification at page 4, last paragraph.

Claims 2-5 have been amended to make changes of a formal nature without narrowing the scope thereof. Claim 10 has been amended to remove the basis for the claim objection appearing on page 2 of the Official Action. All claims as amended are respectfully believed to be sufficiently definite to satisfy the dictates of 35 USC 112, second paragraph.

Claims 1-5 and 7-12 stand rejected as allegedly being anticipated by Pearlstine et al, either alone or with reference to the chemical abstracts registry record information cited at page 3 of the Official Action. Claim 6 stands rejected as allegedly being unpatentable over Peralstine et al in view of Ma et al. Applicant respectfully traverses these rejections.

First, Applicant respectfully notes that the Pearlstine et al reference is not included in the Notice of References Cited, but another reference (Ishizuka et al) having the same patent number with transposed digits is cited. Applicant respectfully requests citation of the Pearlstine et al reference in another Form PTO-892.

The claimed invention is based at least in part upon Applicant's finding that it is possible to form images with reduced uneven glossiness on glossy inkjet media by using an ink composition comprising a polyether-modified polysiloxane compound as a surfactant and by controlling the alkanediol and glycol ether content of the ink composition (see specification at page 4, last paragraph). This is shown in Table 1 on page 30 of the specification, which reports the results of experimentation done using ink compositions wherein the sum total of alkanediol and glycol ether is within the claimed limits (Examples 1-5) and comparative ink compositions wherein the sum total is outside of the claimed limits (Comparative Examples 1-2). As can be seen in Table 1, the ink compositions of the Examples performed better than the ink compositions of the Examples in the evaluations for gloss and uneven glossiness described on pages 29-30 of the specification. (The ink compositions of the Examples and Comparative Examples are described on pages 20-28 of the specification.)

The Examiner considers Pearlstine et al to describe each of the claim limitations, but Applicant respectfully submits that the reference does not teach or suggest the recitation that the sum of (all) alkanediol and glycol ether in the ink composition must be from 10-20 wt%. In the portion of the reference to which the Examiner refers (column 12), the Examiner calculates the sum of HEG + glycol ether (DpNP or PnP). However, this calculation respectfully fails to include DEG, which together with HEG, comprises the sum of the alkanediol content of the described ink compositions. The total content of the alkanediol and the glycol ether in entries 1 and 2 of the table in column 12 is as follows:

Ink Sample No. 1: $\text{DpNP}(10) + \text{HEG}(5) + \text{DEG}(10) = 25\%$

Ink Sample No. 2: $\text{PnP}(10) + \text{HEG}(5) + \text{DEG}(5) = 25\%$

As may be appreciated, the sum of alkanediol and glycol ether in the subject Examples is outside of the claimed range whereby the reference cannot be said to anticipate the claimed invention under 35 USC 102 (see MPEP Section 2131: “To Anticipate A Claim, A Reference Must Teach Every Element Of The Claim”).

Similarly, the Pearlstine reference, either alone or in combination with the secondary reference (even assuming for the sake of argument that it were properly combinable with Ma et al), does not teach or suggest each of the claim limitations and would thus not set forth even a *prima facie* case of obviousness for this reason alone (see MPEP Section 706.02(j)). In particular, the reference or references do not teach or suggest the claim limitation requiring that the total content of alkanediol and glycol ether be from 10-20 wt%. Indeed, there is nothing in

Pearlstine et al or Ma et al that would show or suggest even that the combined sum of alkanediol and glycol ether is a result-effective variable in the claimed ink composition whereby it could not have been obvious to have optimized the same. See MPEP 2144.05 (“A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)”).

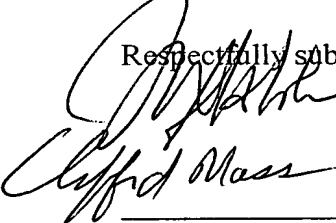
In addition to the above, it is respectfully noted that the Examiner has not provided any alleged motivation for the combination of the cited references whereby the rejection based on the combination is respectfully believed to be deficient for this reason as well (see MPEP Section 706.02(j)). It is noted in this respect that the description in Ma et al at column 2, lines 47-50 refers to the glycol ether as a function group of an acryl monomer and cannot be used to provide a motivation for a combination with the unrelated compounds described in Pearlstine.

Claims 1-3 and 5-12 stand rejected under 35 USC 103(a) as allegedly being obvious over Ishimoto et al. Applicant’s attorney respectfully submits that the reference may be disqualified under the provisions of 35 USC 103(c), and submits the following statement in this regard (see MPEP Section 706.02(I)(2)):

THE PRESENT APPLICATION AND ISHIMOTO ET AL., US PATENT APPLICATION PUBLICATION NO. 20030226473 A1 WERE, AT THE TIME THAT

THE INVENTION OF THE PRESENT APPLICATION WAS MADE, OWNED BY
SEIKO EPSON CORPORATION.

In view of the above, it is respectfully submitted that all rejections and objections of
record have been successfully overcome and that the application is now in allowable form. An
early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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